

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This Amendment is in response to the Office Action dated October 7, 2004. By the present amendment, new claims have been added to further define features of the invention regarding the nature of the updated data to be shared between the first and second mobile terminals.

Briefly, the present invention is directed to an improved approach for updating data in mobile terminals. As discussed in the background of the invention, previous arrangements for updating data have included arrangements for transmitting data from a service provider to each of the mobile units. Alternatively, a web site could be provided for access by the mobile terminal users. However, such prior art arrangements either require the use of a large amount of wireless resources or periodic actions on the part of the users.

Accordingly, the present invention was developed to provide an arrangement to allow updating mobile terminals using a grapevine technique through other mobile terminals. As a fundamental part of this invention, after a first piece of updated data is provided to a first mobile terminal, the first mobile terminal will initiate an inquiry to a second mobile terminal via a communication link. The inquiry asks the second mobile terminal whether it wishes to receive the first update piece of data. The second mobile terminal can then forward a response via the communication link to the first mobile terminal acknowledging that it does, in fact, wish to receive the updated piece of data. In accordance with this response, the first mobile terminal

forwards the first updated piece of data to the second mobile terminal via the communication link.

The updated data itself can be data which is to be shared by the first and second mobile terminals so that they both have the same updated data. For example, as discussed on page 7 of the specification, the data in question can be electronic business card data. Alternatively, the data could be newer versions of software previously installed in the first and second mobile terminals, software patches or operating system upgrades, as well as other types of data. In any event, the present invention provides a simple straight forward arrangement for updating a wide variety of types of data, without the drawbacks of the prior art techniques discussed in the background of the invention.

Reconsideration and allowance of the independent claims 1, 28, 49, 70 and 71 over the cited reference to Littig (USP 5524276) is respectfully requested. In the Office Action it is admitted that Littig:

"fails to specifically disclose initiating an inquiry from the first mobile terminal to a second mobile terminal via a communication link, the inquiry asking the second mobile terminal whether it wishes to receive the first updated piece of data; forwarding a response from the second mobile terminal to the first mobile terminal via the communication link in response to the inquiry from the first mobile terminal, the response acknowledging that it wishes to receive the first updated piece of data."

As such, the Office Action admits that the primary reference to Littig basically fails to disclose two of the four steps recited by claim 1. The Office Action suggests making up for this admitted shortcoming by reversing the features of Littig's technique to arrive at the claimed invention. However, no evidence at all is provided as to why

one of ordinary skill in the art would completely reverse the teachings of Littig to achieve this.

MPEP 2143.01 states that:

"Obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

As apparently recognized by the Office Action, there is no suggestion or motivation for the modification within the Littig reference itself. Instead, the Office Action simply states that:

"such reversal of features would only require routine skill in the art."

Apparently, this is intended to fall within the category of "knowledge generally available to one of ordinary skill in the art" set forth in MPEP 2143.01.

In response to this, Applicants respectfully submits that this statement of reversal of features requiring only routine skill in the art falls far short of the requirements of the MPEP for "knowledge generally available to one of ordinary skill in the art." MPEP 2144.03 specifically addresses "Reliance On Common Knowledge In The Art Or "Well Known" Prior Art." This section of the Manual starts out by noting that it is only appropriate to take such official notice "in limited circumstances." More specifically, MPEP 2144.03 sets forth:

"Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration of being well known."

It is respectfully submitted that, in the present instance, completely reversing the features of Littig is certainly not "of instant and unquestionable demonstration as being well known."

With regard to this, it is respectfully submitted that the statement that "a reversal of features would only require routine skill in the art" falls under the general headings of MPEP 2143.01 of "Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish Prima Facie Obviousness." As noted in that section of the MPEP:

"The mere fact that references can be combined or modified does not render the result and combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 F. 2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)."

The following section of MPEP 2143.01 states, in the heading: Fact That Claimed Invention Is Within The Capabilities Of One Of Ordinary Skill In The Art Is Not Sufficient By Itself To Establish Prima Facie Obviousness." In referring to the case of Ex parte Levengood, 28 USPQ 1300 (B. D. Pat. App. And Inter. 1993), the MPEP notes:

"A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill in the art that the time the claimed invention was made" because the references relied upon teach all aspect of the claimed invention were individually known in the art was not sufficient to establish prima facie case of obviousness without some objective reason to combine the teachings of the references.

As such, it is respectfully submitted that the reasoning relied on in the Office Action for the proposed modification of Littig falls far below the standards required by the MPEP for a proper rejection under obviousness.

In view of the recognized failure of the Littig reference to properly provide any motivation for the proposed modifications, it is respectfully submitted that the statement in the Office Action that this would only require routine skill in the art also comes under the "obvious to try" rationale specifically prohibited by the CCPA in the case of In re Antonie, 195 USPQ 6 (CCPA 1977) and the CAFC in the case of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988). In the case of In re Antonie, the Examiner's position was that working out an optimum efficiency was a matter of mere mechanical experimentation. In response to this, the CCPA stated:

"The PTO and the minority appear to argue that it would always be obvious for one of ordinary skill in the art to try varying every parameter of the system in order to optimize the effectiveness of the system even where there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, obvious to try is not the standard of 35 U.S.C. § 103." 195 USPQ at 8

In a similar manner, the CAFC stated in the case of In re Fine:

"Because neither Warnick or Eads, alone or in combination, suggests the claimed invention, the board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide *detector* in the Eads system...The Eads and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability." 5 USPQ 2d at 1599.

As such, it is respectfully submitted that the present rejection falls within the same "obvious to try" rationale indicated as being improper in the cases of In re Antonie and In re Fine. Therefore, reconsideration and removal of this rejection is respectfully requested.

Beyond the above comments, it is respectfully submitted that Littig actually teaches directly away from the claimed invention. Specifically, Littig teaches in

column 3, lines 12-14 that the ESN and NAM are unique to each of the individual radio units. In column 1, lines 51 et seq., it is stated that "additionally, the defective radio can no longer operate in the radio system since the ESN has been erased from its memory." As such, Littig teaches directly away from the presently claimed invention, rather than toward it. Accordingly, reconsideration and removal of the rejection of the independent claims 1, 28, 49, 70 and 71 over Littig is respectfully requested.

Reconsideration and allowance of dependent claims 2, 3, 29, 30, 50, 51, 53, and 54 over Littig is also respectfully requested. In addition to the above-noted features of their parent independent claims, these claims further define features such as initiating an inquiry from the second mobile terminal to the first mobile terminal, asking the first mobile terminal whether it wishes to receive a second updated piece of information, followed by forwarding a response from the first mobile terminal to the second mobile terminal acknowledging that it does, in fact, wish to receive the second update piece of data which is then forwarded to the second mobile to the first mobile terminal. No such feature is at all suggested in Littig, particularly in combination with the features already noted for the respective parent independent claims. Littig teaches in Fig. 6A that a universal radio can send a protocol B to a defective radio or repaired/replacement radio, while Fig. 6B shows the universal radio sending a protocol A and Fig. 6C shows the universal radio sending a request for external EEPROM data. Although this may be of general interest, it completely fails to teach or suggest the features of the dependent claims 2, 3, 29, 30, 50, 51, 53 and 54.

With regard to the features of dependent claims 4-15 and 31-42, although Littig teaches a communication link can be a wireless arrangement, because of the above-noted shortcomings of Littig in meeting the features of the dependent claims, it is respectfully submitted that this generalized teaching of Littig concerning the wireless communication link fails to teach or suggest the features by these claims 4-15 and 31-42 when considered within the overall system defined by the combination of these claims with their respective parent claims.

Reconsideration and allowance of claims 16-21 and 43-48 over the combination of Littig and Raith (USP 6493550) is also respectfully requested. With regard to this, the Office Action that "Littig, as modified fails to disclose initiating an inquiry comprises forwarding an inquiry via the communication link at preset time intervals." However, Raith is cited with regard to teaching preset time intervals. However, as recognized in the Office Action, Raith teaches "continuously for e.g. every few seconds." Although this may be of general interest, it is respectfully submitted that Raith completely fails to make up for the shortcomings of the Littig reference in meeting the fundamental features of the parent claims which are incorporated into claims 16-21 and 43-38, and certainly fails to teach or suggest the further overall combinations defined by these dependent claims with their respective parent independent claims. Therefore, reconsideration and allowance of these claims over the combination of Littig and Raith is respectfully requested.

Finally, reconsideration and allowance of claims 22, 24 and 26 over the combination of Littig and Erikson (USP 6622018) is also respectfully requested. In the Office Action, it is admitted that Littig fails to teach the specific features of these claims (such as automatically forwarding a response upon receipt of an inquiry, as


defined in claim 22). However, Erikson is relied on in the Office Action to provide motivation for providing these features. Erikson is of general interest with regard to describing a system where one system control one or more systems. However, nothing in Erikson teaches the claimed updating of the overall combination of claims 22, 24 and 26 with their parent claims. Therefore, it is respectfully submitted that claims 22, 24 and 26 clearly define over Littig and Erikson, whether considered alone or in combination with one another, since these references fail to at all suggest the overall features defined by these claims 22, 24 and 26 with their parent claims.

Reconsideration and allowance of the newly presented dependent claims 55-69 is also respectfully requested. These claims define further features regarding the specifics of the updated data itself. As such, claims 55, 60 and 65 define that the first piece of updated data can comprise data that is shared by the first and second mobile terminals so that the first and second mobile terminals will contain the same updated data. The other dependent claims 56-59, 61-64 and 66-69 define that the updated data can be electronic business card data, newer version of software previously installed on the first and second mobile terminals, software patches and/or operating system data. These detailed features regarding the type of updated data are discussed, for example, on pages 4 and 5 and page 7 of the specification. It is respectfully submitted that nothing in the cited primary reference to Littig teaches or suggests the updating of two mobile terminals and the grapevine manner defined by the present claims, whether considered alone or in combination of Raith or Erikson. Therefore, entry and allowance of these newly presented claims 55-69 is respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 0171.39626X00), and please credit any excess fees to such deposit account.

Respectfully submitted,
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By 

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